

REMARKS

SUMMARY:

The subject application sets forth claims 1-36 of which claims 1, 9, 17 and 25 are independent claims.

Applicant notes with appreciation official indication that claims 1-8 and 17-36 have been indicated as allowed and that claims 13-16 have been indicated as containing allowable subject matter and would be allowed if rewritten in independent form including all the limitations of their respective base claims and any intervening claims.

Claims 9-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent Application Publication No. 2001-141615A (Toyo Rubber) in view of Applicant's Admitted Prior Art (AAPA). A response to and traversal of this rejection is now presented in the following section.

35 U.S.C. §103(a) REJECTION (CLAIMS 9-12):

Claims 9-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent Application Publication No. 2001-141615A (Toyo Rubber) in view of Applicant's Admitted Prior Art (AAPA). Based on the comments provided below, Applicant respectfully traverses such rejection and requests reconsideration of claims 9-12.

Original claim 9 of the subject application sets forth a method of characterizing

high speed uniformity of a tire, including in part the steps of providing a manufactured tire, rotating the manufactured tire at a first predetermined rotational speed and obtaining at least one first force measurement, and rotating the manufactured tire at a second predetermined rotational speed and obtaining at least one radial run out measurement.

Numbered pages 2 and 3 of the December 16, 2004 Office Action set forth that Toyo Rubber teaches each of the aforementioned steps of claim 9 in the abstract of such reference, including “rotating the manufactured tire at a first predetermined rotational speed and obtaining at least one first force measurement...[and] rotating the manufactured tire at a second predetermined rotational speed”. The Examiner correctly notes that Toyo Rubber fails to explicitly teach obtaining a radial run out measurement. Applicant further asserts that Toyo Rubber also fails to teach rotating a tire and taking measurements at two distinct rotational speeds as set forth in original claim 9.

Toyo Rubber discloses in the abstract a single step of measuring “the low speed RFV primary component and static unbalance” for a tire. Based on the available disclosure, this single measurement step disclosed in Toyo Rubber cannot be construed as the equivalent of rotating a tire at a first predetermined rotational speed and obtaining at least one first force measurement and also rotating a tire at a second predetermined rotational speed and obtaining at least one radial run out measurement, as set forth in original claim 9.

It is an important aspect of claim 9 that two distinct predetermined rotational speeds, including a separate speed for obtaining radial run out, are utilized in the subject method of characterizing high speed uniformity (HSU). This lies in part because

of the realization in accordance with the present subject matter that high speed radial run out, which can be indicative of mass uneven distribution levels, directly affects high speed uniformity. (See paragraph 6 of the subject application.) Prior technology for characterizing HSU is known to typically utilize only measurements obtained at a single level, namely low speeds. (See, for example, col. 3 lines 6-13 and lines 26-35 of U.S. Patent No. 5,396,438 (Oblizajek) which is part of what the Examiner has referred to as Applicant's Admitted Prior Art (AAPA) in paragraph 5 of the subject application. Such reference discloses technology for assessing the amplitude of highway speed force variations based on measurements taken only at low speeds since low speed measurements are more conveniently obtained.)

Based on the above remarks, Applicant respectfully submits that all elements of claim 9, particularly the distinct steps of obtaining at least one force measurement at a first predetermined rotational speed and separately obtaining a radial run out measurement at a second predetermined rotational speed, are not disclosed singularly or in combination of Toyo Rubber and the prior art references cited by the Applicant. In accordance with §2143.03 of the MPEP, since all claim limitations must be taught or suggested by the prior art (*In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1970)), claim 9 cannot by law be deemed unpatentable over such reference(s). As such, Applicant respectfully requests withdrawal of the 35 U.S.C. §103(a) rejection of claim 9.

Applicants further note that if an independent claim is nonobvious under 35 U.S.C. §103(a), then any claim depending therefrom is nonobvious. (*In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).) With regard to claims 10-12, since such

claims are dependent on otherwise allowable claim 9 based on the above remarks and further limit claim 9, Applicant submits that claims 10-12 should also be allowed.

With regards to the 35 U.S.C. §103(a) rejection of claims 9-12, Applicants further submit that the Examiner has failed in his burden of establishing a *prima facie* case of obviousness to provide a suggestion or motivation to modify Toyo Rubber or to combine Toyo Rubber with the references cited by the Applicant. As mentioned above, none of the references cited in the 35 U.S.C. §103(a) rejection is concerned with obtaining a radial run out measurement at a second predetermined rotational speed distinct from the rotational speed at which at least one force measurement is obtained. In fact, Oblizajek (part of the alleged AAPA) teaches away from obtaining measurements at separate rotational speeds, especially at high speeds such as on the order of 600 rotations per minute or more as set forth in original claim 10, because obtaining low speed measurements is asserted as more convenient. The advantages of obtaining measurements at different speeds, including for example a high speed radial run out measurement, is recognized in part because of Applicant's recognition that high speed radial run out (indicative of mass uneven distribution levels) directly affects high speed uniformity. (See paragraph 6 of the subject application.) Applicant notes in accordance with §2142 of the MPEP that the teaching or suggestion to make a claimed combination and a reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (*In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

Based on the above remarks, Applicant respectfully submits that a *prima facie*

case of obviousness has not been properly established in the rejection of claims 9-12. As such, the rejection of claims 9-12 is respectfully traversed and reconsideration of such claims is requested.

CONCLUSION:

For at least the reasons set forth above, Applicant respectfully submits that the present application and all claims thereof, including claims 9-12, is in complete condition for issuance of a formal Notice of Allowance, and action to such effect is earnestly solicited. The Examiner is invited to telephone the undersigned at his convenience should only minor issues remain after consideration of this response in order to permit early resolution of same.

Respectfully submitted,

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